

Applicant : Robert L. Newell Date: 3/5/04  
Serial No. : 09/993,527 Art Unit: 3732  
Response to Office Action of October 8, 2003

**REMARKS/ARGUMENTS**

Favorable reconsideration is respectfully requested in view of the above amendments and the following discussion.

Each of the claims now in the application presents subject matter which is neither anticipated nor rendered obvious by the prior art. Thus, each of claims 1 through 4 sets forth an improvement in a brush having a single support for applying mascara to eyelashes wherein the brush includes bristles placed in a spiral arrangement having plural turns around the single support. The improvement includes constructing the bristles of the brush of a polyamide fiber having an external surface modified to include a texturized surface configuration with a multiplicity of indents spaced apart along and around the surface configuration so as to provide enhanced pick-up of mascara and subsequent enhanced release of the mascara to the eyelashes. The bristles themselves have a relatively small diameter, and a relatively large number of bristles are provided within each turn of the spiral arrangement. In addition, as set forth in claim 4, the external surface is modified further to include a non-uniform wavy appearance. Likewise, each of claims 6 through 9 sets forth an improvement in a method for applying mascara to eyelashes, the improvement including picking up and applying mascara with a brush having a single support and which incorporates the improved structural

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features set forth above to attain enhanced pick-up of mascara and subsequent release of picked-up mascara to the eyelashes.

All of the claims have been rejected under 35 U.S.C. 103 (a) as being unpatentable over Leone in view of either Burns or O'Brien et al and, with respect to claims 4 and 9, further in view of Fitier.

Leone discloses a mascara application system which employs an application device having a plurality of tines for the application of mascara. In every embodiment of the invention disclosed in Leone, two parallel tines are required in order to apply mascara in accordance with the improvements disclosed in the reference. Hence, all of the objects and advantages sought by Leone are realized through the use of at least two tines on an applicator device. Where bristles are utilized on at least one of these tines, the bristles are non-uniformly disposed so that bristles on inner surfaces of the tines are shorter than bristles on outer surfaces of the tines. Thus, Leone teaches that improved application of mascara is attained through a two-tined construction having a non-uniform distribution of bristles around at least one of the tines. The particular bristle diameter and bristle pitch disclosed in Leone are combined with a multiple-tined device to attain the improvements claimed in the reference.

Neither Burns nor O'Brien et al suggests that any advantage is to be gained by eliminating all but one of the tines of Leone and

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then modifying the bristles of Leone to accomplish an improved result. Leone relies upon multiple tines to accomplish an improved result and suggests nothing applicable to a brush having a single support. Both Burns and O'Brien et al are directed to painting brushes designed to apply paints to surfaces. The requirements of such painting brushes are totally different from the requirements of a mascara-applying brush and any structure provided for attaining the improved application of the paints addressed in these references would not be relevant to attaining an improved application of mascara. O'Brien et al speaks of bristles having diameters very much larger than those set forth in the present claims and, although Burns is silent with respect to bristle diameter, since the reference is directed to similar painting brushes the disclosure is no more relevant than that of O'Brien et al. In fact, Burns specifically addresses brushes designed for painting, powdering, scrubbing sweeping and the like, and does not disclose anything pertinent to the application of mascara utilizing a small, single support brush. While both Burns and O'Brien et al indicate that a textured surface has been available in larger diameter bristles for applying paint, it does not follow that a much smaller diameter bristle would be amenable to a texturized surface, or that such a texturized surface, if placed upon a smaller diameter bristle, would attain an improved result. Indeed, applicant experienced some doubt as to whether or not a small

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diameter bristle could support a texturized surface and whether or not a small diameter bristle could benefit from a texturized surface. However, it has been found that the smaller diameter bristles when used in combination with a larger number of bristles per turn and a texturized surface configuration accomplishes improved pick-up and subsequent improved release of mascara. In summary, there is no suggestion in the proposed combination of references that the use of smaller diameter bristles in a greater number of bristles per turn, combined with a texturized surface, can attain an enhanced pick-up and delivery of mascara. Moreover, while Leone speaks of smaller diameter bristles in a greater number per turn, there is no disclosure of the material from which the bristles are constructed. In fact, Leone indicates that a foam material or a comb construction can be the equivalent of bristles in the disclosed arrangement. Accordingly, Leone does not require that a particular material be employed in order for the disclosed brush to operate in the manner set forth in the reference and there is no suggestion in the reference of any enhanced performance attained by bristles of a particular material or surface configuration. Certainly, the reference does not suggest that a bristle having a texturized surface configuration can be utilized in a construction in which smaller diameter bristles are employed in larger numbers to attain enhanced pick-up and delivery of mascara. Indeed, Leone is concerned only with a two-tined geometry

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for the application of mascara to both upper and lower eyelashes and is not at all concerned with the particular material or structure of the applicator surfaces themselves.

With respect to claims 4 and 9, Fitjer is silent with respect to any indication of bristle size or number and discloses nothing which could anticipate or render obvious the full combination of elements which comprises the improvement set forth in these claims. The proposed combination of Leone with Burns or with O'Brien et al, and further in view of Fitjer, is untenable in rendering obvious the subject matter of the present claims and the rejections based upon the proposed combination should be withdrawn.

Any proposal to combine selected features from the several individual references cited above would not appear to be based upon suggestions in the references themselves, but is prompted by the disclosure in the present application of improvements comprising new combinations of elements which attain heretofore unrealized advantageous results. As such, the proposed combinations of references are untenable in rendering obvious the subject matter of the present claims. Accordingly, it is respectfully requested that the claims be allowed and the application be passed to issue.